



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,701	01/30/2001	Jonathan Allan Coates	IAFG 14 C2	9492

24999 7590 04/09/2003

MILLEN, WHITE, ZELANO & BRANIGAN, PC  
2200 CLARENDON BLVD  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER

KRASS, FREDERICK F

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 04/09/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/771,701

Applicant(s)

COATES ET AL.

Examiner

Frederick Krass

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-58 is/are pending in the application.
- 4a) Of the above claim(s) 25-30, 34-39 and 43-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 31-33, 40-42 and 49-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/835,964.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **Obviousness Rejection**

Claims 19-24, 31-33, 40-42 and 49-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rideout et al (USP 4,724,232) in view of Liotta et al (USP 5,539,116).

This rejection is maintained.

Applicant states that the previous Office Action failed to disclose where in the secondary reference the (-) enantiomer of BCH-189 was disclosed. The examiner does not need to point out what is self-evident. A reference is considered for the totality of what it teaches, not just the sections the examiner uses for illustration. The negative enantiomer is disclosed repeatedly throughout the specification. In fact, the last two lines of the abstract preceding the patent refers to "enantiomerically enriched" BCH-189, and the first three claims are explicitly drawn to the isomer in question.

It is true that column 2, lines 60-64 do not refer to the (-) isomer in so many words. However, the passage cannot be taken out of context to be limited to racemic mixtures. If the (-) isomer is the subject of the entire patent and its claims, and the prior art clearly prefers the (-) isomer for its advantageous properties, then it is fair to say that a disclosure of equivalency between AZT and BCH-189 includes the (-) isomer by implication, if not by outright disclosure.

**Obviousness-Type Double Patenting Rejection**

1) Claims 20-24, 31-33, 40-42 and 49-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-26, 41-45 and 53-60 of U.S. Patent No. 6,180,639 in view of Liotta et al (USP 5,539,116).

2) Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 27-40 and 46-52 of U.S. Patent No. 6,180,639.

These two rejections are maintained. Applicant has chosen to defer responding to them in a substantive manner until allowable subject matter has been indicated (see page 2 of Applicant's response).

**Rejection is Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 1614

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (703) 308-4335. The examiner can normally be reached on Monday, Tuesday and Thursday from 9am to 5pm and on Friday from 11am to 7pm. The examiner is off Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached at (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0193.

Frederick Krass  
Primary Examiner  
Art Unit 1614

